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IN THE

Supreme Court of the United States

OCTOBER TERM, 1934.

Nos. 255 and 256.

ALTOONA PUBLIX THEATRES, INC.,
Petitioner,

AND

WILMER & VINCENT CORPORATION and LOCUST STREET REAL ESTATE COMPANY,
Petitioners,

v.

AMERICAN TRI-ERGON CORPORATION and TRI-ERGON HOLDING, A. G.,
Respondents.

PETITIONERS' MEMORANDUM OF LAW RE AUTHORITIES CITED BY RESPONDENTS

I.

The petitioners' brief (pp. 47-49) points out that in considering the issue of validity in this case, the Court of Appeals disregarded the claims that are in suit, and treated the patent as if it were for a certain five-element combination which is not made the subject of any claim.

In the respondents' brief (pp. 58-60), an effort is made to justify this; but the cases cited are not in point.

The true rule is that it is the *claims* of a patent that measure the invention. *Smith* v. *Snow,* 55 S. Ct. 279, 283, ——— U. S. ———. The patentee's rights must be tested by what he actually claims. *Keystone Bridge Co.* v. *Phœnix Iron Co.,* 95 U. S. 274, 278. Each claim must embody a complete invention and is, in fact, an independent patent for the subject matter it defines, deriving no assistance from other claims. *Leeds & Catlin* v. *Victor Talking Machine Co.,* 213 U. S. 301, 319. Claims for one thing cannot by construction be changed into claims for something else. *White* v. *Dunbar,* 119 U. S. 47, 51. A claim cannot be treated as covering a combination of certain elements unless it specifies all of those elements. *Brown Mfg. Co.* v. *David Bradley Mfg. Co.,* 51 Fed. 226, 227; *Burden* v. *Corning,* 2 Fish. Pat. Cas. 495.

There is no justification for the Court of Appeals' disregard of the claims in issue, or its failure to examine into the question whether, when considered individually, those claims represent invention over the prior art.* As we have pointed out in our brief (pp. 15-46), none of them does.

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* In a footnote at page 40 of their brief, the respondents put forward a proposition of law regarding what is "prior art", which is contrary to the weight of authority. See *Hazeltine Corp.* v. *R. E. B. Service Corp.,* 8 Fed. Supp. 100, 105 (D. C., E. D. N. Y.), a recent decision by the same Judge who previously decided the *Allied Metal* case cited by the respondents in their footnote; *Blumenthal & Co.* v. *Salt's Textile Mfg. Co.,* 21 F. (2d) 470, 473 (D. C. Conn.); *Hazeltine Corp.* v. *R. C. A.,* 52 F. (2d) 504, 509 (D. C., S. D. N. Y.); and *Denaro* v. *Maryland Baking Co.,* 50 F. (2d) 1074 (C. C. A. 4; affirming 40 F. (2d) 513, 515, 516). Furthermore, even if the law were as the respondents assert, it would not apply to any patent that is vital to the defense of invalidity of the claims in suit.

II.

In the petitioners' brief (pp. 59-70) we assert that the disclaimer filed on the eve of the trial of this case is invalid because it purports to do what can be lawfully done only by reissue, namely, to change the character of the claimed invention. In the respondents' brief (pp. 62, 63) it is urged that the disclaimer is valid because it does not broaden the claims and because the added elements are disclosed in the patent and are included in one or more of the claims of the patent as issued.

The cases cited by the respondents do not support their position in this regard, as we shall now point out.

In *Dunbar* v. *Myers,* 94 U. S. 187, 191, the claim was for a power driven saw. It began, "1. The employment or use of the deflecting plates, *one or both,* placed at the sides of the saw, as shown." This is an "alternative" claim. In later years the Patent Office has declined to allow claims of that character. They amount, in effect, to two separate and different claims. It is as if the patentee had had two claims in the same words except that one specified *both* plates and the other specified *one* plate. The disclaimer, which the Court approved, struck out the words "one or" before the word "both". This merely eliminated one of two claimed alternatives and corresponded to the cancelling of a complete claim to the "one plate" combination, had the patentee used separate claims in place of the alternative claim. It is to be noted also that the defenses to the suit (see opinion, p. 188) did not include that of invalidity of the disclaimer

In *Hurlbut* v. *Schillinger,* 130 U. S. 456, again, the defendant did not attack the disclaimer (see p. 458). The suit was upon a reissue patent containing two claims, one of which was the same as the single claim of the original patent, being limited to the construction of a pavement

with "tar-paper or equivalent" between the adjoining blocks of concrete. The new claim of the reissue read:

> "1. A concrete pavement laid in detached blocks or sections, substantially in the manner shown and described."

The specification described as an alternative the laying of the blocks with nothing between the adjoining edges. The disclaimer eliminated from the specification that part of the description. The disclaimer, therefore, made the new claim of the reissue the same as the other claim which was brought over from the original patent, and *the effect was merely to strike out one of the two claims.* It did not set up as the invention some new combination not passed upon by the Patent Office.

Carnegie Steel Co. v. *Cambria Iron Co.,* 185 U. S. 403, involved a disclaimer which did not touch the claims; it eliminated parts of the specification. The defendant did not attack the validity of the disclaimer (see p. 409). As to the disclaimer the Court said (p. 436):

> "* * * Had the purpose of the disclaimer been to reform or alter the description of the invention, or *convert the claim from one thing into something else,* it might have been objectionable, *as patents can only be amended for mistakes of this kind by a reissue.* But the disclaimer in this case appears to have been made *to obviate an ambiguity in the specification,* and with no idea of obtaining the benefit of a reissue."

Obviously, the case does not support respondents' proposition.

In *Minerals Separation Co.* v. *Butte, etc.,* 250 U. S. 336, as the decision states (p. 354), the disclaimer merely made the claims to which it applied the equivalent of claims *allowed by the Patent Office and found valid in previous litigation,* which is anything but the situation now before the Court.

In contrast with the foregoing cases, it will be observed that the disclaimer in *Hailes* v. *Albany Stove Co.*, 123 U. S. 582 (our brief, pp. 65, 66), *was one which both limited the claims and conformed to the original disclosure,* and yet was condemned by this Court. The claim, which originally covered a fire pot for a stove with air openings anywhere throughout the entire depth of the sides, was limited by a disclaimer to one with openings in "substantially the lower half" (p. 587). The original drawing showed the openings not throughout the entire depth, but extending upwardly from the bottom nearly two-thirds of the way (see p. 585); so that the disclaimer limiting the invention to the use of openings in "substantially the lower half", was not a departure from the actual disclosure of the application. The objection which this Court evidently had to the disclaimer was that it was of a kind to "change the character of the invention" as originally described and claimed (p. 587, and see the comments of the Court quoted at p. 66 of our brief). The same objection applies to the disclaimer filed by the respondents in this case.

In the *Hailes* v. *Albany Stove Co.* case just cited, this Court said (p. 587):

> "* * * A disclaimer is usually and properly employed for the surrender of a *separate claim* in a patent, or some other *distinct and separable matter,* which can be exscinded without mutilating or changing what is left standing."

The statement of invention in the patent here in suit as it finally issued includes two "distinct and separable" features, namely, (1) an alleged improvement in "propulsion mechanisms for linear phonogram records"[1], and (2) "a dependable and highly efficient optical system"[2] for film phonographs, this second feature having been injected

[1] Vol. III, page 5, lines 44, 45.

[2] Vol. III, page 5, lines 56, 57.

into the application as a pure afterthought nearly seven years after it was filed (our brief, pp. 10, 38). This second feature is an excellent example of something that might have been "exscinded [by disclaimer] without mutilating or changing what is left standing". Indeed, since it is wholly foreign to the original statement of invention, it should have been. But the respondents did not exscind that feature or any other distinct and separable matter. On the contrary, their "disclaimer" amended each claim and changed the character of the invention defined by it. For example, the disclaimer amendment to claim 13 which, as issued, was directed to the *second* of the two features mentioned above, goes so far as to *add to that claim the wholly distinct first feature.* This is indeed a far cry from "exscinding" by disclaimer.

The disclaimer filed by the respondents in this case, being without sanction of Statute, is invalid.

Respectfully submitted,

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